REMARKS

A. The Examiner has failed to establish a *prima facie* basis for the rejection of claims 22 and 24 under 35 USC §112, first paragraph and the phrase in question, "in which the primary fibers are polymer fibers other than polypropylene", is not new matter.

In the Office Action of 20 May 2005 the Examiner continues to reject claims 22 and 24 under 35 USC §112 first paragraph as new matter. The reason given for this rejection is, ". . . because there is not expressed support for the negative limitation in the specification. *Ex Parte Grasselli*, 231 USPQ 393". It is not believed that this rejection will withstand scrutiny and the Applicants respectfully request the Examiner to reconsider the rejection in light of the following comments.

Upon careful review it is clear that the Examiner has misinterpreted the holding in the cited *Ex parte Grasselli* decision. This case does not stand for the proposition that an application must suggest an exclusion. This is made very clear from reviewing the Board of Patent Appeals and Interferences' own interpretation of the *Grasselli* decision in the subsequently decided case of *Ex parte Parks*, 30 USPQ2d 1234 (Bd. Pat. App. & Int. 1994). Referring to *Ex parte Grasselli*, that decision states,

> Under the particular facts in that case, it was held that the negative limitation introduced new concepts in violation of the description requirement of the first paragraph of 35 USC 112, citing *In re Anderson, supra*. In the situation before us, it cannot be said that the originally filed disclosure would not have conveyed to one having ordinary skill in the art that Appellants have possession of the *concept* of conducting the decomposition step generating nitric acid in the absence of a catalyst. See, for example, column 5 of the '562 patent, first paragraph, wherein Fig. 4 is discussed. Pyrolysis temperatures of between 600 degrees C and 700 degrees C, and above 700 degrees C were employed to achieve conversion of chemically bound nitrogen to nitric oxide. Smooth conversion was obtained above 700 degrees C, while the optimum conversion was found to occur above 900 degrees C. Throughout the discussion which would seem to cry out for a catalyst if one were used, no mention is made of a catalyst.
> . . . Thus, it cannot be said that the originally filed disclosure would not have conveyed to one having ordinary skill in the art the *concept* of effecting decomposition at an elevated temperature in the absence of a catalyst. (Emphasis in original.)

The paragraph bridging pages 5 and 6 of the present specification reads as follows:

> The primary fibers 16 can be any type of fibers suitable for providing good structural qualities as well as good acoustical and thermal properties. Preferred fibers for use as the primary fibers 16 are polymer fibers. It is to be understood that the primary fibers can specifically be any mineral fibers such as fibers made of rock, slag and basalt, as well as glass fibers such as wool glass fibers, not shown. Wool glass fibers are well known in the art. A preferred type of primary fibers for use with the invention are made of polyethylene terephthalate (PET) fibers, preferably having a diameter within the range of from about 3 to about 30 microns. The primary fibers are preferably present in an amount that is within the range of from about 30 to about 95 percent by weight of the blanket of fibers, exclusive of the facing, and the bicomponent binder fibers are preferably present in an amount within the range of from about 5 to about 70 percent by weight. Most preferably, the primary fibers are PET fibers that are present in an amount that is within the range of from about 40 to about 80 percent by weight of the whole insulation product, exclusive of facings, and the bicomponent binder

fibers are present in an amount within the range of from about 20 to about 60 percent by weight.

This paragraph identifies the primary fibers as any mineral fibers such as fibers made of rock, slag and basalt, as well as glass fibers such as wool glass fibers. Further, the paragraph identifies polyethylene terephthalate fibers as a preferred type of primary fiber. The paragraph then goes on to indicate most preferably the primary fibers are polyethylene terephthalate fibers in an amount that is within the range of from about 40 to about 80% by weight of the whole insulation product. Clearly, polyethylene terephthalate fibers are not polypropylene. Just as clearly this is full and complete disclosure of the concept of utilizing "polymer fibers other than polypropylene" for the present invention. Undoubtedly, the present invention as set forth in claims 22 and 24 has support in the original specification and this rejection under 35 USC §112 should be withdrawn.

It should also be noted that in *In re Johnson*, 194 USPQ 187, 196, 558 F.2d 1008, 1009 (CCPA 1977), it was explicitly held that where a written description supports the claims in the absence of a negative limitation added to overcome a prior art rejection, it must by definition describe the part remaining after the amendment. Specifically, the opinion states, "[h]ere . . . the "written description" in the 1963 specification supported the claims in the absence of the limitation, and that specification having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on,

under these circumstances, to indicate the appellants are merely excising the invention of another, to which they are not entitled, and are not creating an 'artificial subgenus' or claiming 'new matter'". *Id.* The meaning of the language in this decision is clear. Similarly, the application of this law to the present fact pattern is clear. The Examiner is bound to follow the case law and, therefore, can only rightfully reach one conclusion. The rejection of claims 22 and 24 must be withdrawn as improper.

Such a decision is also completely consistent with the decision of the Court in *In re Saunders*, 170 USPQ 213, 220, 444 F.2d 599, 607 (CCPA 1971). In the present case the inventor has decided to merely excise that portion of the present invention disclosed in the present application wherein the primary fibers are made of polypropylene. The applicant is well within his rights to do so since it is for the inventor to decide what bounds of protection he will seek.

B. U.S. Patent 5,773,375 to Swan et al. fails to anticipate the invention as set forth in claims 1-9, 15-18, 21 and 23.

The standard for lack of novelty or "anticipation" is one of strict identity. As stated by the Court of Appeals for the Federal Circuit in Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90, 802 F.2d 1367, 1379 (Fed. Cir. 1986), "[i]t is axiomatic that for prior art to anticipate under § 102 it has to meet every element of

the claimed invention . . . ." Further, as set forth at MPEP § 2141.02, "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)(emphasis in original). Guided by these precedents, any rejection of pending claims 2-9, 15-18, 21 and 23 based upon anticipation is clearly improper and should be withdrawn.

More specifically, at col. 1 lines 20-27, the Swan et al. reference explicitly teaches that melt-blown microfibers are an "extremely efficient acoustical insulation material". It then states that "in terms of cost, processability and performance a preferred blown microfiber web for this use is formed out of polypropylene." The Swan et al. reference then goes on to note that "the problem with polypropylene in the fiber form is that it is susceptible to degradation, particularly thermal degradation." Further, at col. 2 lines 50-55, the Swan et al. reference states:

> The present invention relates to the use of thermally stabilized polypropylene melt-blown microfiber acoustical insulation webs for sound attenuation. The webs exhibit superior acoustical properties, namely sound absorption and transmission loss properties.

Clearly, the utilization of melt-blown polypropylene fibers in an insulation web is a critical aspect of the Swan et al. patent and it is the objective and intent of the patent to thermally stabilize these fibers for such use. Thus, considering the Swan et al. reference "as a whole", it positively and absolutely teaches the use of melt-blown polypropylene fibers in any insulation web.

In stark and total contrast, independent claims 15, 21 and 23 of the present application all reference an acoustical insulation product wherein the blanket of polymer fibers includes primary fibers "substantially free of melt-blown fibers." Since melt-blown fibers are at the very core of the Swan et al. reference and its teachings, the Swan et al. reference cannot possibly anticipate the presently claimed product including primary fibers substantially free of melt-blown fibers.

The relevant teachings of Carey et al. and EP 0538047 A1 relate to bicomponent fibers and fail to address the shortcoming noted above with respect to the primary reference to Swan et al. Stated another way, the Swan et al. reference clearly teaches that melt-blown polypropylene is the fiber of choice for acoustical insulation and nothing in Swan et al., Carey et al. or EP 0538047 A1 (whether considered alone or in combination) suggests otherwise. Thus, independent claims 15, 21 and 23 should be allowed.

Claims 2-9 and 11 which now depend from claim 21 and are rejected on the same grounds are equally allowable for the same reasons. Claims 16-18 which depend from claim 15 are also equally allowable for the same reasons.

C. Claims 11, 20, 22 and 24 clearly patentably distinguish over U.S. Patent 5,773,395 to Swan et al. when considered in further combination with U.S. Patent 4,840,832 to Weinle et al.

As indicated above, the primary reference to Swan et al. explicitly teaches utilizing melt-blown polypropylene as the primary fibers in an acoustical

insulation product. The Examiner cites the Weinle et al. reference to teach the concept of utilizing polyethylene terephthalate bicomponent fibers as the binder fibers. This is described in the Weinle et al. patent at, for example, col. 4 lines 10-21.

Claim 11 of the present application depends from claim 21 and reads on an acoustical insulation product including among other structures a blanket of polymer fibers including primary fibers substantially free of melt-blown fibers. Claim 11 further defines the primary fibers as being made from polyethylene terephthalate. Such a structure is simply neither shown nor suggested by the Swan et al. and Weinle et al. references.

More specifically, the primary reference to Swan et al. is solely and exclusively concerned with acoustical insulation incorporating melt-blown polypropylene fibers. This is in stark and total contrast to the insulation product set forth in present claim 11 which incorporates primary fibers "substantially free of melt-blown fibers". While the secondary reference to Weinle et al. does disclose the concept of utilizing polyethylene terephthalate bicomponent fibers as binder fibers in an insulation product, the Weinle et al. reference does nothing to address the shortcoming noted above with respect to the primary reference to Swan et al. thus, the combination of references fails to teach or suggest the present invention and claim 11 should be allowed.

Claim 20, unlike claim 11, depends from independent claim 15. Independent claim 15 does, however, also include a reference to polymer fibers

including primary fibers "substantially free of melt-blown fibers". Since the primary reference to Swan et al. explicitly teaches to one skilled in the art a preference for melt-blown polypropylene fibers, this combination of references fails to provide any basis whatsoever to support the rejection of claim 20.

Claims 22 and 24 still further define over the cited art since both of these claims refer to insulation products having primary fibers other than polypropylene. As noted above, the primary reference to Swan et al. explicitly relates to and teaches the use of

polypropylene fibers in preference to all other fibers when making insulation products. Thus, once again, it should be appreciated that the cited references teach away from the present invention and claims 22 and 24 should be allowed.

As stated above, MPEP §2141.02 requires that an Examiner consider a prior art reference in its entirety including those portions that would lead away from the claimed invention. While it is true that the cited reference to Weinle et al. refers to a headliner incorporating polymeric fibers such as "polyester, nylon, polyethylene, polypropylene and blends of fibers formed from these polymers and copolymers" (note col. 4 lines 2-6) in combination with polyethylene terephthalate bicomponent binder fibers, the Examiner cannot ignore the teachings of the Swan et al. reference that would lead one skilled in the art away from the claimed invention. In this regard it is particularly important to note that while the Weinle et al. reference issued in 1989, the Swan et al. reference is more recent, issuing in 1998. The Swan et al. reference explicitly teaches the concept of making

acoustical insulation material from melt-blown polypropylene fibers because such an approach provides advantages in terms of *cost, processability and performance* (see col. 1 lines 20-27). This newer reference clearly takes precedent and suggests to one skilled in the art that the primary fibers in an insulation product should be made of melt-blown polypropylene.

Accordingly, when considered together, the Swan et al. and Weinle et al. references might suggest to one skilled in the art to prepare an insulation product from primary fibers of melt-blown polypropylene and binder fibers of bicomponent polyethylene terephthalate but in no way would the combined references suggest to one skilled in the art to manufacture a product made in accordance with the teachings of the present invention. Only with hindsight and the utilization of the knowledge and teachings of the present invention as a guide would it be possible to utilize the disclosure in the Swan et al. and Weinle et al. references to arrive at the claimed invention. It, of course, is well established that such use of hindsight is not a proper criteria for resolving the issue of obviousness and, accordingly, these claims must be allowed. See *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Int. 1985).

In summary, all the pending claims patentably distinguish over the prior art. Upon careful review and reconsideration of these issues in view of the preceding comments, it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly

solicited. If any fees are required pertaining to this Reply, the Examiner is authorized to debit Deposit Account No. 50-0568.

Respectfully submitted,

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